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APPLICANT(S) : Douglas W. CONMY, et al.   CONFIRMATION NO.: 1268

SERIAL NUMBER : 09/345,448   EXAMINER : Ahn LY

FILING DATE : July 1, 1999   ART UNIT : 2172

FOR : SYSTEM AND METHOD FOR ENABLING A USER TO SUBSCRIBE TO UPDATES FROM INFORMATION SOURCES

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §1.192

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Sir:

Further to the Notice of Appeal filed on June 16, 2004, Appellants herewith submit Appellants' Brief on Appeal in triplicate pursuant to 37 C.F.R. §1.192(a).

In accordance with §1.17(c), a check in the amount of $340.00 representing the fee for filing an Appeal Brief is attached. It is believed that no other fees are due in connection with this submission beyond those that otherwise may be provided for in documents accompanying this paper. However, if it is determined otherwise, the Commissioner is authorized to credit any overpayment or charge any deficiencies to the undersigned's account, Deposit Account No. 50-0311, Reference No. 042846-0313060.

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I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation.

II. RELATED APPEALS AND INTERFERENCES

Based on information and belief, there are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 1-4, 6-9, 11-19, 21-35, and 37 are pending in this application. Claims 1-4, 6-9, 11-19, 21-35, and 37 stand rejected. Claims 1-4, 6-9, 11-19, 21-35, and 37 are appealed.

IV. STATUS OF AMENDMENTS

Appellants have not amended the claims subsequent to the Final Office Action dated December 18, 2003.

V. SUMMARY OF THE INVENTION

A. General Summary of the Invention

The invention relates to a system and method for providing a user with information updates related to topics of interest from various information sources. *See* specification at page 2, lines 19-21. The system may provide a subscription of updates based on periodic searches of one or more non-web object stores to retrieve information requested by a user. *See id.* at page 5, lines 14-17. Generally, systems enabling this type of "push" delivery of updated information included in an object store are limited to online object stores. *See id.* at page 2, lines 1-3.

While such systems usually enable a user to input search criteria using a predetermined template, the system in the instant application may enable a user to input search criteria for performing the search using a selection formula. *See*

id. at page 8, lines 8-9. A user may input, for example, lines of program code that identifies search criteria. *See id.* at page 8, lines 9-10. A "Check Syntax" function may be displayed as a selectable button that is used to determine whether the code input in the selection formula is correct. *See id.* at page 8, lines 11-13. *See id.* at page 3, lines 4-7. Based on a request for a subscription, the system may perform periodic searches of non-web object stores in accordance with the search criteria to retrieve updated information. *See id.* at page 3, lines 7-11.

B. Summary of the Invention With Respect to Claims 1-4, 21-23, and 33-35

Some embodiments of the invention may include subscription requesting means. In an exemplary embodiment, the subscription requesting means may include a request object, which may be implemented as a software modules, that enables a request of a subscription. *See id.* at page 2, lines 27-29. For example, FIG. 5 illustrates an exemplary embodiment of a request object (subscription view 100) that may enable the user to request a subscription. The subscription requesting means may include a selection formula (selection formula field 114) that is programmed by the user. *See id.* at page 8, lines 8-10. The selection formula may include lines of program code that includes search criteria. *See id.* at page 6, lines 7-9.

According to various embodiments of the invention, the system may include subscription parameter receiving means. In an exemplary embodiment, the subscription parameter receiving means may include an update system. The update system may perform a receive criteria step by receiving criteria input by a user. *See id.* at page 6, lines 20 and 21.

In some embodiments of the invention, the system may include search performing means. In an exemplary embodiment, the search performing means may include an update system. The update system may retrieve, scan, and filter information desired by a user. *See id.* at page 5, line 19. In some embodiments,

the search performing means may search appropriate object stores (*e.g.* databases) on a random basis, which, in some cases, may be determined by a user. *See id.* at page 6, lines 8 and 9.

According to various embodiments of the invention, the system may include subscription retrieving means. In an exemplary embodiment, the subscription retrieving means may include an update system. The update system may retrieve objects from one or more object stores that match a search criteria. *See id.* at page 7, lines 3 and 4.

In some embodiments of the invention, the system may include subscription notification means. In an exemplary embodiment, the subscription notification means may include an update system. The update system may notify a user of objects that match a search criteria. *See id.* at page 7, lines 4 and 5.

According to some embodiments of the invention, the system may include option input means. In an exemplary embodiment, the option input means may include radio buttons, pull-down menus, and/or other selectable mechanisms that may receive an option relating to the subscription from the user. *See id.* at page 7, lines 16 and 17; and page 8, lines 5 and 6.

In some embodiments of the invention, the system may include subscription presenting means. In an exemplary embodiment, the subscription presenting means may include an update system. The update system may present a subscription to a user at a present objects step. *See id.* at page 7, lines 9-11. In some instances, the subscription may be presented as an electronic mail message. *See id.* at page 3, lines 17-21.

According to various embodiments of the invention, the system may include syntax checking means. In an exemplary embodiment, the syntax checking means may include a "Check Syntax" function. *See id.* at page 8, lines 11-17. The "Check Syntax" function may be displayed as a selectable button. *See id.*

In some embodiments of the invention, the system may include subscription disabling means. The subscription disabling means may include a "Temporarily disable this subscription" option. *See id.* at page 8, lines 20-22.

VI. GROUNDS OF REJECTION

1. Claims 1, 6, 11, 16, 33-35, and 37 are rejected under 35 USC § 103(a) as allegedly being obvious in view of Peckover.

2. Claims 2, 3, 7, 8, 14, 15, 17, and 18 are rejected under 35 USC § 103(a) as allegedly being obvious in view of Peckover and further in view of Conklin.

3. Claims 4, 9, 12, 13, 19, and 21-32 are rejected under 35 USC § 103(a) as allegedly being obvious in view of Peckover and further in view of Freeman.

VII. ARGUMENT

Each of the rejections of the pending claims are improper and should be reversed. For at least the following reasons, all pending claims (1-4, 6-9, 11-19, 21-35, and 37) are patentably distinguishable over the cited references.

The Examiner has failed to establish a *prima facie* case that claims 1, 6, 11, 16, 33-35, and 37 are obvious in view Peckover. The asserted rejection is improper at least for failing to teach or suggest all of the features of the claimed invention. Further, the rejection is improper at least for failing to provide the proper motivation to combine the references.

The Examiner has failed to establish a *prima facie* case that claims 2, 3, 7, 8, 14, 15, 17, and 18 are obvious in view of Peckover and Conklin. The asserted rejection is improper, at least because Peckover and Conklin, both alone and in combination with one another, fail to teach or suggest all of the features of the claimed invention. Further the rejection based on Peckover and

5

Conklin is improper for failing to provide the proper motivation to combine the references.

The Examiner has failed to establish a *prima facie* case that claims 4, 9, 12, 13, 19, and 21-32 are obvious in view of Peckover and Freeman. The asserted rejection is improper, at least because there is no legally proper suggestion or motivation to combine Peckover and Freeman, and because Peckover and Freeman, both alone and in combination, fail to teach or suggest all of the features of the claimed invention.

A. Requirements for Establishing a *prima facie* Case of Obviousness

As stated in the *Graham v. John Deere*, three requirements must be met to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). 383 U.S. 1, 148 USPQ 459 (1966). The requirements are: (1) the prior art must teach or suggest all the claim elements, (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings, and (3) there must be a reasonable expectation of success.

Appellants submit that at least the first two requirements are not met by the asserted rejections. Therefore, Appellants examine those requirements in further detail.

1. To establish a *prima facie* case of obviousness, all of the claim elements must be taught or suggested by the prior art reference(s).

To establish *prima facie* obviousness of a claimed invention, all the claim elements must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

2. To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to modify the references.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Thrift*, 298 F.3d 1357, 63 USPQ2d 2002 (Fed. Cir. 2002).

B. Rejection Under 35 U.S.C. §103(a), as Allegedly Obvious, in view of Peckover

1. Claims 1, 6, 11, 13, and 16

The rejection of claims 1, 6, 11, and 16 under 35 U.S.C §103(a) as allegedly being obvious in view of Peckover is improper at least for failing to teach or suggest all of the features of the claimed invention.

Independent claim 1 recites in part:

...the subscription requesting means including a selection formula, wherein the *selection formula is programmed by the user*...(emphasis added)

Independent claims 6, 11, and 16 recite similar features. Peckover fails to teach or suggest this feature.

The Examiner acknowledges that "Peckover does not clearly disclose ...selection formula," because "these options are programmed in the application before displayed to the user." *See* the Final Office Action, mailed December 18, 2003, at page 4, 1st full paragraph. However, in the ***Response to Arguments*** section of the rejection, the Examiner apparently argues that entering search criteria into a product template displayed as a combination of fill-in fields, selection lists, radio buttons, etc., is "equivalent" to programming a selection formula. *See id.* at the last full paragraph, *and* Peckover at column 28, lines 17-48.

The product template disclosed in Peckover does not teach or suggest a selection formula that is **programmed** by a user. For instance, an exemplary embodiment of the selection formula is described in the Specification, and illustrated in Figure 1 (element 114), as enabling lines of program code to be input by a user. *See* the Specification at page 8, lines 8-10. In contrast, Peckover apparently teaches that a user, "following the instructions, completes the search criteria in the product template." Peckover at column 28, lines 43 and 44. Filling in blank spaces, activating buttons, and/or making selections from selection lists within a template, as is disclosed in Peckover, does not teach or suggest programming a selection formula.This approach differs from the claimed invention at least for the reason that the user's search criteria are limited to what is in the template. The use of search formulas enables greater flexibility and combinations of enabled criteria that may or may not be available with a simple template.

Additionally, the Examiner's assertion that the product template of Peckover teaches or suggests a selection formula that is programmed by a user is inconsistent with the plain meaning of the word program. The Examiner must give the words in the claims their plain meaning. *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ 2d 1857 (Fed. Cir. 2004). THE AMERICAN HERITAGE® DICTIONARY OF THE ENGLISH LANGUAGE, FOURTH EDITION, defines the word program as, "[t]o provide (a machine) with a set of coded working instructions." This definition supports the Examiner's original characterization of the product template disclosed in Peckover as "options [that] are programmed in the application **before** displayed to the user" (emphasis added), and therefore does not teach or suggest a selection formula that is programmed by a user. *See* the Final Office Action, mailed December 18, 2003, at page 4, 1st full paragraph.

The Examiner's assertion that the product template of Peckover teaches or suggests a selection formula that is programmed by a user is also inconsistent with the specification of the instant application. For example, FIG. 5 illustrates an

exemplary embodiment of a subscription view that includes both a template (options 106, 108, and 110), similar to the one illustrated in Peckover, in combination with a selection formula (selection formula 114). The inclusion of a template, separate from a selection formula illustrates that these are construed as separate search criteria input mechanisms within the context of the application.

For at least these reasons, Appellants submit that the Examiner has failed to establish a *prima facie* case of obviousness with regards to claims 1, 6, 11, and 16. Accordingly, the rejection of these claims must be reversed. Claims 2-4, 7-9, 12-15, 17-19, and 21-35 depend from and add additional features to one of independent claims 1, 6, 11, and 16. Therefore, claims 2-4, 7-9, 12-15, 17-19, and 21-35 are allowable, at least, by virtue of their dependency.

2. Claim 33

Appellants submit that the rejection of claim 33 under 35 U.S.C §103(a) as allegedly being obvious in view of Peckover is improper at least for failing to teach or suggest all of the features of the claimed invention.

Dependent claim 33 recites, in pertinent part:

> ...syntax checking means for determining whether code input in the programmed selection formula is correct.

Peckover does not teach or suggest this feature.

The Examiner asserts, without any evidentiary support, that figures 40 and 41 disclose syntax checking means. They do not. The Examiner does not identify any particular element or feature illustrated in these figures that is being applied as syntax checking means. This failure to support this assertion with an evidence constitutes an improper rejection. For at least this reason this rejection should be reversed.

Furthermore, as set forth above, figures 40 and 41 do not show a code input into the programmed selection formula. Thus, Peckover fails to teach or

suggest syntax checking means for determining whether code input in the programmed selection formula is correct.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness with regards to claim 33. Accordingly, the rejection of this claim must be reversed.

3. Claim 34

The rejection of claim 34 under 35 U.S.C §103(a) as allegedly being obvious in view of Peckover is improper at least for failing to teach or suggest all of the features of the claimed invention.

Dependent claim 34 recites in pertinent part:

> subscription disabling means for temporarily discontinuing the subscription for a predetermined period of time.

Peckover does not teach or suggest this feature.

The Examiner asserts that Peckover discloses this feature and relies on column 30, lines 38-45 for support, which has been repeated below for convenience:

> "Intermediate results from extended searched are delivered periodically according to the consumer's desired delivery period. When the desired delivery time is reached (step 362), Preference Manager 54 organizes the not-yet-delivered results according to the consumer's preferences (step 364). For example, results that mention favored brands are ordered before results with less favored brands... "

At best, the cited portion of Peckover merely enables a consumer to specify a time, or time intervals, for delivery. Specifying a time or time intervals for delivery is not temporarily discontinuing the subscription for a predetermined period of time. Thus, Peckover does not teach or suggest all of the elements of the claimed invention.

For at least this reason, Appellants submit that the Examiner has failed to set forth a *prima facie* case of obviousness for claim 34, based on Peckover. Accordingly, the rejection of this claim must be reversed.

4. Claim 35

The rejection of claim 35 under 35 U.S.C §103(a) as allegedly being obvious in view of Peckover is improper at least for failing to teach or suggest all of the features of the claimed invention.

Dependent claim 35 recites in part:

wherein the search criteria corresponding to the subscription is an electronic mail message containing a predetermined text.

Peckover does not teach or suggest this feature.

In an exemplary embodiment, a user may open an email application and select a "Create" button and a "Subscription" option. A subscription view is presented that permits the user to create a subscription based on a selected search criteria, to that object store. For example, a user may create a subscription for electronic mail messages containing predetermined text. *See* the Specification at page 3, lines 14-19.

The Examiner takes the position that Peckover discloses this feature and relies on column 5, lines 40-45 for support, which has been repeated below for convenience:

"Electronic commerce addresses many of the disadvantages of traditional commerce. It is convenient and inexpensive to prepare and deliver e-mail to specific persons or groups of persons. Many computer systems are repositories for immense databases that are useful for commerce... "

The passage cited by the Examiner appears to merely state the general advantage of using email to communicate in commerce. However, the cited passage contains no reference or teaching regarding search criteria corresponding to the subscription that is an electronic mail message containing a predetermined text. Thus, Peckover does not teach or suggest all of the elements of the claimed invention.

For at least this reason, the Examiner has failed to set forth a *prima facie* case of obviousness for claim 35, based on Peckover. Accordingly, the rejection of this claim must be reversed.

5. Claim 37

The rejection of claim 37 under 35 U.S.C §103(a) as allegedly being obvious in view of Peckover is improper at least for failing to teach or suggest all of the features of the claimed invention.

Independent claim 37 recites in pertinent part:

...enabling a user to input a selection formula.

Peckover fails to teach or suggest this feature.

The Examiner acknowledges that "Peckover does not clearly disclose ...selection formula." *See* the Final Office Action at page 4, 1st full paragraph. However, in the *Response to Arguments* section of the Final Office Action the Examiner maintained that:

> "When a user or customer or subscriber who wants to have the target or relevant or desired information or product (col. 5, lines 62-67 and col.6, lines 1-25), have to enter the search query including the keyword describing the search criteria (col. 28, lines 17-48 and col. 29, lines 1-15 and lines 26-40) from which the search for a product or subscription is performed...All these are the keywords, query, and criteria are entered or programmed by the user..."

Regarding the selection formula, the Examiner further stated:

> "Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the product database as a non-web document and selection screen displayed as in fig. 40 and 41 for searching with the criteria..." (see page 4, 2d full paragraph of the December 18 2003 Final Office Action).

Peckover does not teach or suggest enabling a user to input a selection formula. In an exemplary embodiment of the invention, a user may request objects matching a selection formula. A user may input lines of code that identifies search criteria. *See* specification page 8, lines 8-10.

In contrast, the Web page screen disclosed in Peckover enables a user to select or specify search criteria for searching automobiles (See figures 41 and 42 of Peckover). These user specified search criteria are then processed by

background programs associated with the Web page screen. Even the Brand, Model, and Merchant text fields are not programmed with code. At best, these fields accept text words as additional search criteria. Peckover does not teach or suggest enabling a user to input a selection formula, as set forth in claim 37. Furthermore, Peckover does not teach or suggest a selection formula as set forth in Appellants' specification at, page 8, lines 8-10 and Figure 1, element 114. Thus, Peckover does not teach or suggest all of the features of the claimed invention.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness with regards to claim 37. Accordingly, the rejection of this claim must be reversed.

C. Rejection Under 35 U.S.C. §103(a), as Allegedly Obvious, Peckover In View of Conklin

1. Claims 2, 3, 7, 8, 14, 15, 17, and 18

The rejection of claims 2, 3, 7, 8, 14, 15, 17, and 18 under 35 U.S.C §103(a) as allegedly being obvious in view of Peckover and further in view of Conklin is improper, because Peckover and Conklin, alone or in combination, fail to teach or suggest all of the features of the claimed invention.

Dependent claim 2 recites in pertinent part:

...wherein the search performing means performs the search of the at least one database on a random basis.

Claims 7, 14, and 17 recite similar features. Claims 3, 8, 15, and 18 depend from, and add to, claims 2, 7, 14, and 17, and therefore include the features recited in claims 2, 7, 14, and 17. Peckover and Conklin, alone or in combination, fail to teach or suggest this feature.

The Examiner acknowledges that Peckover fails to disclose the search of the at least one database on a random basis. *See* the Final Office Action at page 8, paragraph number 8. The Examiner relies on Conklin to disclose this feature.

In particular, the Examiner cites column 29, lines 12-47 of Conklin for support, which has been repeated below, in relevant part, for convenience:

> [A]nother principal sponsor function is promoting visibility 213-04. In this capacity, a sponsor 06 may submit its own Website and URL's to a number of Internet search engines and submit each selling participants' Websites and URL's to such search engines as soon as the seller is registered and has created a Website. A typical sponsor's promote visibility functions 213-04 formats the URL's and domain names...into META Tags and Meta Keywords or similar formats and submission schedules most likely to speed up registration with the search engines. For example, the ALTAVISTA™ search engine Web site states that:
>
> > . The Altavista indexer gives higher priority for keywords located in submit tags (META Tags and Meta Keywords), a higher priority for keywords that are located near the top of the page, and also gives a tad higher ranking for keywords appearing closer to each other on the page text...
>
> ...Since, as noted above, it may take ALTAVISTA™ search engine and others, as many as three months or more to **index** a site on a purely random basis, submissions such as this can significantly improve the visibility of the new seller Websites from the outset.

The cited portion of Conklin is apparently drawn to a search engine that uses META tags and Meta keywords to index new web sites. Conklin teaches that it may be desirable to submit a new web site to a search engine with formatted META tags and Meta keywords so as to enable the search engine to register the web site more efficiently. The Examiner appears to be relying on the teaching in Conklin that in the absence of META tags and Meta keywords submitted by the new website, the search engine may index the web site on a random basis, which may take much longer than the disclosed method.

Conklin does not teach or suggest search performing means that performs the search of the at least one database on a random basis because the cited portion of Conklin is drawn to a method of indexing websites as an alternative to random indexing, not searching databases. In fact, the portion of Conklin relied on by the Examiner does not even relate to searching a database for information matching a subscription. Therefore, Peckover and Conklin, both alone and in

14

combination with one another, fail to teach or suggest search performing means that performs the search of the at least one database on a random basis.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness based on Peckover in view of Conklin with regards to claims 2, 3, 7, 8, 14, 15, 17, and 18. Accordingly, the rejection of these claim must be reversed.

D. Rejection Under 35 U.S.C. §103(a), as Allegedly Obvious, Peckover In View of Freeman

1. Claims 4, 9, and 19

The rejection of claims 4, 9, and 19 under 35 U.S.C §103(a) as allegedly being obvious in view of Peckover and further in view of Freeman is improper for at least failing to provide a proper suggestion or motivation to combine the references.

Dependent claim 4 recites in pertinent part:

...option input means for enabling a user to input one or more options relating to the subscription.

Claims 9 and 19 recite similar features.

The Examiner acknowledges that Peckover fails to disclose input means for enabling a user to input one or more options relating to the subscription. *See* the Final Office Action at page 10, paragraph number 9. The Examiner relies on Freeman to disclose this feature. The Examiner alleges that such a combination would have been motivated to "provide an information system with any of multiple electronic information objects such as, e-mail, web page, or non-web document for mass distributing to the requested subscriber." *Id.*

In order to establish obviousness, the combination of the teachings of the prior art to produce the claimed invention must be motivated either (1) explicitly or (2) implicitly in the references themselves, or (3) in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. § 2143.01.

The references themselves to not provide explicit support for the Examiner's motivational statement. As the Examiner acknowledges, Peckover fails to disclose input means, and does not teach or suggest modifying the disclosed system to provide multiple information objects, as the Examiner alleges would have been obvious. Freeman appears to be directed to facsimile transmissions sent between parties over phone lines. *See* Freeman at col. 1, lines 6-8. Freeman does not provide any disclosure that supports the Examiner's motivational statement. For example, Freeman includes no discussion of "mass distributing" materials to multiple subscribers.

The alleged motivation of the Examiner to combine the references is not provided implicitly within the references. Implicit support for combining references is evaluated by looking to the combined teachings of the references, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole. *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1596 (Fed. Cir. 2000).

Motivation to combine the Peckover and Freeman would not have been motivated by the knowledge generally available to one of ordinary skill in the art because, as was addressed above, the disclosures are drawn to different fields of art. Further, the Examiner does not assert that the supposed motivation for combining the references may be based on the knowledge available to one of ordinary skill in the art.

In the present instance, the combined teachings of the references, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole do not provide motivation to combine the references because Peckover and Freeman seem to be drawn to separate problems, within separate fields. Peckover appears to deal with gathering and analyzing market transaction data to assist the activities of market participants within an electronic market. *See* Peckover at col. 1, lines 13-18. In contrast, Freeman is apparently directed to a system and method that delivers facsimile messages as object files inserted in, or attached to, e-mails. *See* Freeman at the Abstract. Due to the separate

16

and distinct natures of the fields of invention of the references, the combined teachings of the references do not provide motivation for combining a system and method for delivering facsimile messages, as disclosed in Freeman, with gathering and analyzing market transaction data, as set forth in Peckover, at least because they deal with separate fields of invention, and thus, one of ordinary skill in the art would not have been motivated to combine the references in the manner proposed by the Examiner.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness based on Peckover in view of Conklin with regards to claims 4, 9, 12, 19, 22, 25, 28, and 31. Accordingly, the rejection of these claim must be reversed.

2. Claims 21, 24, 27, and 30

The rejection of claims 21, 24, 27, and 30 under 35 U.S.C §103(a) as allegedly being obvious in view of Peckover and further in view of Freeman is improper at least for failing to disclose all the features of the claimed invention, alone or in combination, and for failing to provide the proper motivation or suggestion for combining the references.

Claim 21 recites in pertinent part:

...wherein the at least one database is a Lotus Notes database.
Claims 24, 27, and 30 recite similar features.

The Examiner acknowledges that Peckover fails to disclose wherein the at least one database is a Lotus Notes database. *See* the Final Office Action at page 11, second paragraph. The Examiner relies on Freeman to disclose this feature.

In particular, the Examiner cites column 4, lines 36-67 and column 5, lines 1-6 for support, which has been repeated below, in relevant part, for convenience:

> An e-mail subscriber also subscribes to a facsimile-delivery-to-electronic-mail system. The subscriber issued a specially designated phone number for receiving facsimile messages via e-mail...

17

...The e-mail subscriber or facsimile receiver specifies a file format to which a native facsimile object file is to be translated...

...There are also some **e-mail client applications, such as Microsoft Exchange and Lotus Notes** that are capable of reading and displaying facsimile transmitted graphic images...

...A facsimile server is equipped with various application file translation software programs for translating native facsimile files to subscriber selected formats. A file translation specification is based on a subscriber request, according to the software application that the subscriber uses. For example, if the subscriber uses **Microsoft Exchange or Lotus Notes, or other e-mail client applications** capable of displaying graphic images, the subscriber will request no translation...

It appears that using a Lotus Notes client e-mail application to access e-mail messages may include some advantages within the system described in Freeman. However, the cited portions of Freeman do not include any reference to a Lotus Notes Database. In fact, these passages in Freeman do not reference a database of any kind. Thus, Peckover and Freeman, both alone and in combination with one another, fail to teach or suggest all of the features of the claimed invention.

Further, the Examiner's purported motivation for combining the references is improper. The motivational statement included in the rejection is identical to the alleged motivation applied by the Examiner in the rejection of claim 4. *See* the Final Office Action at page 11, lines 18-22. For the reasons provided above, this motivation is improper.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness based on Peckover in view of Conklin with regards to claims 21, 24, 27, and 30. Accordingly, the rejection of these claim must be reversed.

3. Claims 22, 25, 28, and 31

The rejection of claims 22, 25, 28, and 31 under 35 U.S.C §103(a) as allegedly being obvious in view of Peckover and further in view of Freeman is improper for at least failing to provide a proper suggestion or motivation to combine the references.

Claim 22 recites in pertinent part:'

...subscription presenting means for presenting the subscription to the user.

Claims 25, 28, and 31 recite similar features.

The Examiner admits that Peckover does not teach subscription presenting means for presenting the subscription to the user. *See* the Final Office Action at page 12, lines 1-3. The Examiner relies on Freeman to provide a teaching of this feature. *See id.* at page 12, lines 4 and 5. The Examiner's motivational statement for providing this feature of Freeman to Peckover is identical to the Examiner's motivation for combining the references to allegedly teach the features of claim 4. *See id.* at page 12, lines 8-12. For the reasons provided above, this combination is improper for a lack of motivation.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness based on Peckover in view of Conklin with regards to claims 22, 25, 28, and 31. Accordingly, the rejection of these claim must be reversed.

4. Claims 23, 26, 29, and 32

The rejection of claims 23, 26, 29, and 32 under 35 U.S.C §103(a) as allegedly being obvious in view of Peckover and further in view of Freeman is improper for at least failing to provide a proper suggestion or motivation to combine the references.

Claim 23 recites in pertinent part:

...wherein the subscription presenting means presents the subscription as an electronic mail message.

Claims 26, 29, and 32 recite similar features.

The Examiner acknowledges that Peckover fails to disclose subscription presenting means that presents the subscription as an electronic mail message. *See* the Final Office Action at page 12, third paragraph. The Examiner relies on Freeman to disclose this feature. *See id.* The Examiner's motivational statement for providing this feature of Freeman to Peckover is identical to the Examiner's motivation for combining the references to allegedly teach the features of claim 4. *See id.* For the reasons provided above, this combination is improper for a lack of motivation.
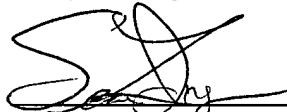
For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness based on Peckover in view of Conklin with regards to claims 23, 26, 29, and 32. Accordingly, the rejection of these claim must be reversed.

CONCLUSION

Because the references relied upon by the Examiner, either alone or in combination with one another, fail to disclose, teach or suggest all of the features of the claims as set forth above, Appellants request that the rejection of each of pending claims 1-4, 6-9, 11-19, 21-35, and 37 under 35 U.S.C. §103 be reversed.

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Respectfully submitted,

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21

CLAIMS APPENDIX

1.   **(Previously Presented)** A system for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising:

subscription requesting means for enabling a user to request a subscription of at least one non-web document from at least one database, the subscription requesting means including a selection formula, wherein the selection formula is programmed by the user, the selection formula including search criteria corresponding to the subscription, wherein the search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention;

subscription parameter receiving means for receiving at least one subscription parameter from the user wherein the at least one subscription parameter indicates a type of information to retrieve;

search performing means for performing a search of the at least one database for information matching the subscription;

subscription retrieving means for retrieving the information matching the subscription; and

subscription notification means for notifying the user of matched and retrieved information.

2.   **(Previously Presented)** The system of claim 1, wherein the search performing means performs the search of the at least one database on a random basis.

3.   **(Previously Presented)** The system of claim 2, wherein the search performing means performs the search on a random basis selected by the user.

4.   **(Previously Presented)** The system of claim 1, further comprising

22

option input means for enabling a user to input one or more options relating to the subscription.

5.   **(Cancelled)**.

6.   **(Previously Presented)** A system for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising:

a subscription requesting object that enables a user to request a subscription of at least one non-web document from at least one database, the subscription requesting object including a selection formula, wherein the selection formula is programmed by the user, the selection formula including search criteria corresponding to the subscription, wherein the search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention;

a subscription parameter receiving object that receives at least one subscription parameter from the user, wherein the subscription parameter indicates a type of information to retrieve;

a search performing object that performs a search of the at least one database for information matching the subscription;

a subscription retrieving object that retrieves the information matching the subscription; and

subscription notification means for notifying the user of matched and retrieved information.

7.   **(Previously Presented)** The system of claim 6, wherein the search performing object performs the search of the at least one database on a random basis.

8.   **(Previously Presented)** The system of claim 7, wherein the search

performing object performs the search on a random basis selected by the user.

9.   **(Previously Presented)** The system of claim 6, further comprising an option input object that enables a user to input one or more options relating to the subscription.

10.   **(Cancelled)**.

11.   **(Previously Presented)** A method for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising the steps of:

requesting a subscription for at least one non-web document from at least one database, wherein the request includes a selection formula programmed by a user, the selection formula including search criteria corresponding to the subscription, wherein the search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention;

receiving at least one subscription parameter from the user, wherein the at least one subscription parameter indicates a type of information to be retrieved;

performing a search of the at least one database for information matching the subscription;

retrieving the information matching the subscription; and

notifying the user of matched and retrieved information.

12.   **(Previously Presented)** The method of claim 11, further comprising the step of presenting the information to the user.

13.   **(Previously Presented)** The method of claim 11, further comprising the step of periodically searching the at least one database.

14.   **(Previously Presented)** The method of claim 13, wherein the step of periodically searching the at least one database is performed on a random

24

basis.

15. **(Previously Presented)** The method of claim 14, wherein the step of periodically searching the at least one database is performed on a periodic basis selected by the user.

16. **(Previously Presented)** A processor readable medium having processor readable code embodied therein for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising:

subscription requesting processor readable code for causing a processor to request a subscription of at least one non-web document from at least one database, the subscription requesting processor readable code including a selection formula programmed by a user, the selection formula including search criteria corresponding to the subscription, wherein the search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention;

subscription parameter receiving processor readable code for causing a processor to receive at least one subscription parameter from the user wherein the at least one subscription parameter indicates a type of information to retrieve;

search performing processor readable code for causing a processor to perform a search of the at least one database for information matching the subscription;

information retrieving processor readable code for causing a processor to retrieve the information matching the subscription; and

subscription notifying processor readable code for causing a processor to notify the user of matched and retrieved information.

17. **(Previously Presented)** The medium of claim 16, wherein the search performing processor readable code performs the search of the at least

one database on a random basis.

18.   **(Previously Presented)** The medium of claim 17, wherein the search performing processor readable code performs the search on a random basis selected by the user.

19.   **(Previously Presented)** The medium of claim 16, further comprising option input processor readable code for causing a processor to enable a user to input one or more options relating to the subscription.

20.   **(Cancelled).**

21.   **(Previously Presented)** The system of claim 1, wherein the at least one database is a Lotus Notes database.

22.   **(Previously Presented)** The system of claim 1, further comprising subscription presenting means for presenting the subscription to the user.

23.   **(Previously Presented)** The system of claim 22, wherein the subscription presenting means presents the subscription as an electronic mail message.

24.   **(Previously Presented)** The system of claim 6, wherein the at least one database is a Lotus Notes database.

25.   **(Previously Presented)** The system of claim 6, further comprising subscription presenting means for presenting the subscription to the user.

26.   **(Previously Presented)** The system of claim 25, wherein in the subscription presenting means presents the subscription as an electronic mail message.

27. **(Previously Presented)** The method of claim 11, wherein the at least one database is a Lotus Notes database.

28. **(Previously Presented)** The method of claim 11, further comprising the step of presenting the subscription to the user.

29. **(Previously Presented)** The method of claim 28, wherein the presenting step presents the subscription as an electronic mail message.

30. **(Previously Presented)** The medium of claim 16, wherein the at least one database is a Lotus Notes database.

31. **(Previously Presented)** The medium of claim 16, further comprising subscription presenting processor readable code for causing a processor to present the subscription to the user.

32. **(Previously Presented)** The medium of claim 31, wherein the subscription presenting processor readable code presents the subscription as an electronic mail message.

33. **(Previously Presented)** The system of claim 1, further comprising syntax checking means for determining whether code input in the programmed selection formula is correct.

34. **(Previously Presented)** The system of claim 1, further comprising subscription disabling means for temporarily discontinuing the subscription for a predetermined period of time.

35. **(Previously Presented)** The system of claim 1, wherein the search criteria corresponding to the subscription is an electronic mail message containing a predetermined text.

36. **(Cancelled).**

37. **(Previously Presented)** A method for enabling a system user to request a subscription of at least one document from at least one database, comprising the steps of:

enabling a user to input a selection formula, said selection formula including search criteria corresponding to a subscription, wherein said search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention;

performing a search in said at least one database to identify the information corresponding to said search criteria of said selection formula;

retrieving said identified information; and

presenting said retrieved information to the user.

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